



PATENT
P56056

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SUNG-SOO LEE

Serial No.: 09/580,221

Examiner: PARK, CHAN S.

Filed: 26 May 2000

Art Unit: 2622

For: METHOD FOR CONTROLLING FAX DATA TRANSMISSION ACCORDING
TO AN OUTPUTTING WAY OF A RECEIVING PART

PETITION UNDER 37 C.F.R. §1.181

Mail Stop: Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant respectfully request reconsideration and withdrawal of the finality of the rejection of the last Office action (Paper No. 20050505) mailed on 20 May 2005, and as reasons therefore states that:

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I.D.: REB/SS/sb

STATEMENT OF FACTS

1. Applicant filed a patent application on 26 May 2000 setting forth claims 1-17.
2. The U.S. Patent and Trademark Office mailed a non-final Office action (Paper No. 4) on 10 March 2004. Claims 1-3, 5, 8-10, 13 and 14 were rejected under 35 U.S.C. §102(e) as being anticipated by Kujirai et al. (U.S. Patent No. 6,278,524). Claims 4, 6, 7, 11-12 and 15-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kujirai and further in view of Ogura (U.S. Patent No. 4,876,609).
3. Applicant filed a Response on 3 June 2004. There was no claim amendments in the Response filed on 3 June 2004.
4. The U.S. Patent and Trademark Office mailed a non-final Office action (Paper No. 6) on 27 August 2004. Claims 1-6 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki (JP03-274943) in view of Konno et al. (U.S. Patent No. 6,154,286). Claims 7 and 9-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Suzuki (JP03-274943) and Konno et al. (U.S. Patent No. 6,154,286) and further in view of Ogura (U.S. Patent No. 4,876,609). Claims 13-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki (JP03-274943) in view of Konno et al. (U.S. Patent No. 6,154,286) and further in view of Bloomfield (U.S. Patent No. 6,693,729).

5. Applicant filed an Amendment on 24 November 2004. Claim 1, 2, 4-8, 11, 13, 15 and 17 were amended, and claims 18-20 were newly added in the Amendment filed on 24 November 2004.
6. The U.S. Patent and Trademark Office mailed a final Office action (Paper No. 20050505) on 20 May 2005. Claim 18 is rejected under 35 U.S.C. §112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claim 20 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 5-7 are rejected under 35 U.S.C. §102(e) as being anticipated by Yoshida et al. (U.S. Patent No. 6,449,063). Claims 2 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida and further in view of Ishizuka et al. (U.S. Patent No. 5,282,050). Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida and further in view of Suzuki (JP03-274943). Claims 8, 9, 11, 12 and 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida et al. (U.S. Patent No. 6,449,063) in view of Ishizuka et al. (U.S. Patent No. 5,282,050). Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida and Ishizuka and further in view of Suzuki (JP03-274943). Claims 13 and 15-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yoshida et al. (U.S. Patent No. 6,449,063) in view of Ishizuka et al. (U.S. Patent No. 5,282,050) and further in view of Bloomfield (U.S. Patent No. 6,693,729). Claim 14 is rejected under 35 U.S.C.

§103(a) as being unpatentable over Yoshida, Ishizuka and Bloomfield and further in view of Suzuki (JP03-274943).

7. Applicant filed an Amendment on 18 August 2005. Claims 1 and 20 were amended in the Amendment filed on 18 August 2005. The Applicant asked the Examiner to withdraw the finality of the rejection.
8. The U.S. Patent and Trademark Office mailed an Advisory Action (Paper No. 20050831) on 9 September 2005. The Examiner has maintained the 35USC102 and 103 rejections of claims 1-20 including 35USC102 rejection of claims 1, 5-7 under Yoshida et al.(U.S. Patent No. 6,449,063), and 35USC103 rejection of claims 2 and 4 over Yoshida and Ishizuka et al. (U.S. Patent No. 5,282,050). The Examiner also maintained his rejection of Claim 3 under 35 U.S.C. 103(a) over Yoshida and Suzuki Japanese publication No. 03-274943. The Examiner also maintained that claims 8, 9, 11, 12 and 18-20 are rejected under 35 U.S.C. 103(a) over Yoshida and Ishizuka and claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) over Yoshida, Ishizuka and Bloomfield (U.S. Patent No. 6,693,729). The Examiner maintained the finality of the rejection.

REMARKS

The Applicant respectfully believes that the final Office action (Paper No. 20050505) mailed on 20 May 2005 is a premature final Office action for the following reasons.

The Applicant asks that the finality of the rejection be removed based on the changing of the motivation to combine and addition of the motivation to combine when none was ever given in the final rejection as seen in claims 4, 11, 13 and 14.

In addition, the Examiner stated that the new grounds for rejection are necessitated by the amendments by the Applicant. However, respectfully, this statement is not accurate. As seen in claim 1 for example, the amendment was only done for clarification reasons of lending consistency in the use of facsimile as it seen in line 3. However, this should not afford a whole new rejection and new references applied. The same is true for the amendments of claims 1, 2, 4-8, 11, 13, 15 and 17.

The *Manual of Patent Examining Procedure* (MPEP) states “Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art” (MPEP § 706.07(a)).

Therefore, the MPEP § 706.07(a) indicates that a second action on the merits will not be

made final if it includes a rejection, on newly cited art, of any claim not amended by applicant in spite of the fact that other claims may have been amended to require newly cited art.

Furthermore, the definition of “a new ground for rejection” does not only refer to newly cited references, but to the below mentioned new grounds for rejection as MPEP 706.07(a) specifically mentions the case of newly cited references separately from “a new ground for rejection” afterwards as “Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.” Therefore, here, the Applicant’s amendments did not necessitate the new grounds for rejection.

Moreover, as mentioned in MPEP §706.07, “ Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application....The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”

Therefore, here the change in motivation to combine and the additional references applied do not afford a clear issue being developed as it does not give the Applicant proper ability to respond to the rejection.

For all of the foregoing reasons, the Applicant respectfully believes that the Paper No. 20050505 is a premature final Office action because of the new grounds for rejection of claims 1-20 were not necessitated by amendment nor based on information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p). In addition, the Examiner had to modify or add motivation to combine where no motivation was given or not given properly in claims 4, 11, 13 and 14.

RELIEF REQUESTED

In view of the above, Applicant respectfully requests the Commissioner to:

- A. Reconsider the finality of the rejection of the last Office action (Paper No. 20050505);
- B. Withdraw the finality of the last Office action (Paper No. 20050505); and
- C. Grant such other and further relief as justice may require.

Respectfully submitted,



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